



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/847,843

05/01/2001

Noboru Ogino

01269-LH

7322

1933

7590

09/27/2006

FRISHAUF, HOLTZ, GOODMAN & CHICK, PC

220 Fifth Avenue

16TH Floor

NEW YORK, NY 10001-7708

EXAMINER

THOMPSON, JAMES A

ART UNIT

PAPER NUMBER

2625

DATE MAILED: 09/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

09/847,843

Applicant(s)

OGINO, NOBORU

Examiner

James A. Thompson

Art Unit

2625

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 13 September 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☒ Applicant's reply has overcome the following rejection(s): rejection of claim 13 under 35 USC §112, 2<sup>nd</sup> paragraph.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 4-15.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☒ Other: see attached.

## DETAILED ACTION

### *Response to Amendment*

1. The proposed amendments to claim 13 overcome the rejection of claim 13 under 35 USC §112, 2<sup>nd</sup> paragraph, as set forth in items 2-3 of the previous office action dated 10 June 2006 and mailed 16 June 2006, and do not substantively alter the prior art rejections or the substance of claim 13. There are no other amendments to the claims. Accordingly, the **proposed amendments to the claims are entered.**

### *Response to Arguments*

2. Applicant's arguments, see page 8, lines 16-23, filed 13 September 2006, with respect to the rejection of claim 13 under 35 USC §112, 2<sup>nd</sup> paragraph have been fully considered and are persuasive. The rejection of claim 13 under 35 USC §112, 2<sup>nd</sup> paragraph listed in items 2-3 of said previous office action has been withdrawn.

3. Applicant's arguments filed 13 September 2006 have been fully considered but they are not persuasive.

Regarding page 9, line 2 to page 11, line 2: Claim 4 recites that "said controller is configured to store the document size designated for a document placed on said document table in a state where said cover is closed". Claim 4 does not recite "preventing an image from being read in a wrong read size in a situation where automatic detection for the size of a document on a document table fails", as argued by Applicant on page 10 of the present arguments. Hisatake discloses "a controller (figure 19(52) and column 21, lines 50-56 of Hisatake) which specifies a

read size corresponding to the document size designated by said user interface (column 12, lines 61-64 and column 13, lines 1-7 of Hisatake) and which controls said document reader to read the image of the document in the read size (column 21, lines 50-56 of Hisatake); wherein said controller is configured to store the document size designated for a document places on said document table in a state where said cover is closed (figure 8 and column 12, lines 54-64 of Hisatake), and to refer to the stored document size as the read size of the document placed on the document table even when the reading of the document on said document table is interrupted by reading an image of a document fed by said document feeder (column 12, lines 61-64 of Hisatake)", as specifically recited by claim 4.

**Regarding page 11, line 3 to page 14, line 4:** Applicant again relies upon aspects of the specification rather than limitations specifically recited in the claims. Applicant is respectfully reminded that, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

As recited in claim 4, a user interface (figure 8; figure 19(53); and column 21, lines 50-53 of Hisatake) designates a document size for the document to be read by said document reader (figure 8(Sheet); column 12, lines 61-64; and column 13, lines 1-7 of Hisatake). Furthermore, said controller is configured to store the document size designated for a document placed on said document table in a state where said cover is closed (figure 8 and column 12, lines 54-64 of Hisatake), and to refer to the stored document size as the read size of the document placed on the document table even when the reading of the docum-

Art Unit: 2625

ent on said document table is interrupted by reading an image of a document fed by said document feeder (column 12, lines 61-64 of Hisatake), as specifically recited by claim 4. By setting the job, a user specifically sets the details of the print job, including the size of the document, for all of the pages of the document (column 12, lines 61-64 of Hisatake). Thus, the interruption that naturally occurs when a new document page is fed by the document feeder does not cause a change in the preset document size.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Thompson whose telephone number is 571-272-7441. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



18 September 2006

James A. Thompson  
Examiner  
Technology Division 2625



**DAVID MOORE**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2600**